

REMARKS

I. Introduction

Claims 21 to 42 are pending in the present application. In view of the following remarks, it is respectfully submitted that claims 21 to 42 are allowable, and reconsideration is respectfully requested.

Applicants respectfully request acknowledgment of the claim for foreign priority, as well as the indication that all certified copies of the priority documents have been received.

II. Objections to the drawings

The drawings have been objected to. In particular, the Office asserts that “Figures 6-8 are not of sufficient quality to permit examination.” (*Office Action*, page 2, section 3.)

It is respectfully submitted that the Office does not explain, nor is it readily apparent, why Figures 6 to 8 have been objected to. It believed that the claimed subject matter is sufficiently described by the figures and that a more detailed illustration is not essential and is not required for a proper understanding of the claims, especially by a person having ordinary skill in the art. Indeed, *under 37 C.F.R. § 1.81 (a) Applicants are only “required to furnish a drawing of [the] invention where necessary for the understanding of the subject matter sought to be patented.”*

It is therefore respectfully requested that the objection to the drawings be withdrawn.

III. Rejection of Claims 34 to 41 under 35 U.S.C. § 112, ¶ 2

Claims 34 to 41 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

Regarding claim 34, the Office Action contends that “[i]t is unclear which elements in Figures 1 and 6 or from [the] specification correspond to” certain features of the claimed subject matter. (*See Office Action*, page 3, section 4.) With regard to claim 37, the Office Action contends that “[i]t is unclear ... which elements in figures 1-8 or from [the]

specification correspond to two first electrodes of amperometric sensor, two electrodes of Nernst cell and two pump electrodes of pump cell”

It is respectfully submitted that if upon review of a claim in its entirety, the Office concludes that a rejection under 35 U.S.C. 112, ¶ 2 is appropriate, an analysis as to why the phrase(s) used in the claim are “vague and indefinite” should be included in the Office action. *M.P.E.P.* § 2173.02. The Office has not included any such analysis. Instead, the Office Action asserts that it is, for example, unclear where certain electrodes are with respect to Figures 1 and 6, which is completely unrelated to whether the phrases or terms of the claim are vague and indefinite. In this regard, it is further noted that the claims recite the invention. Their purpose is not to explain how the invention works. That role is left to the specification. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558 (Fed. Cir. 1983). Since claim 34 is clear and gives rise to no ambiguity, it therefore satisfies the requirements of 112, ¶ 2.

Notwithstanding the above, the figures together with the specification clearly describe how to practice the subject matter of claim 34, e.g., at page 14, line 21; to page 15, line 32.

Regarding claims 35, 36 and 40, the Office is apparently unclear as to the following terms and phrases: “reference electrode,” “storage volume,” “diffusion barrier,” and “diffusion path.” It is respectfully submitted that the cited terms and phrases are definite and clear as used and as would be understood when each of the rejected claims is read in view of the specification — which is the proper objective standard. As to the cited terms and phrases, as to each of the claims in which they occur, the specification of the present application clearly and specifically describes each term and phrase. In this regard, the Office’s attention is respectfully directed to Figures 6 to 8 with the understanding that, for example, a “reference electrode” is 33; a “storage volume” is 18; a “diffusion barrier” is 14; and a “diffusion path” is 19.

In view of the foregoing, it is respectfully submitted that the presently pending claims comply with the second paragraph of § 112 *since a person having ordinary skill in the art would understand what is claimed when the claim is read in view of the specification*. See *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 U.S.P.Q.2d 123 (Fed. Cir. 1993).

IV. Rejection of Claims 21 to 24, 26, 30 to 36, 40, and 42 under 35 U.S.C. § 103(a)

Claims 21 to 24, 26, 30 to 36, 40, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,495,027 to Stahl et al., (“Stahl”) in view of U.S. Patent No. 4,021,137 to Joshi et al. (“Joshi”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

Claim 21 pertains to a device for measuring pressure in a gas mixture. It includes the feature of *an arrangement **configured to fix**, at least during a pressure measuring phase, a mole fraction of a gas component drawn upon for the pressure measurement upstream of the diffusion barrier to a constant 100%.* The Office Action concedes that Stahl “is silent to [a] mole fraction to a constant 100%.” (*Office Action*, page 5, section 5.) Nonetheless, the Office Action rejects independent claim 21, contending that the secondary Joshi reference provides the necessary disclosure. In particular, the Office Action asserts that Joshi “teaches a solid electrolyte electrochemical cell where in the electrodes across the electrolyte transport > 99% pure oxygen” and that “it would be obvious ...that Stahl[‘s] first pump cell can also perform to pump > 99% pure oxygen” (*Office Action*, pages 5 to 6, section 5.)

It is respectfully submitted that the issue is not whether Stahl is capable in performing a certain way. Rather, the issue is whether one skilled in the art would have combined the Stahl and the Joshi references as suggested in the Office Action in order to make a *prima facie* case of obviousness against that which is recited in the claim. In this regard, the statements in the Office Action in support of the obviousness rejection is completely devoid of any explanation why one of ordinary skill in the art would modify the Stahl reference to include the features of the Joshi reference to arrive at the present invention, as defined in the claims. None of the exemplary rationales identified by the Supreme Court in *KSR* have been offered to explain the Office’s conclusions of obviousness (*See* M.P.E.P. § 2143). In short, the Office bears the initial burden of presenting a proper *prima facie* unpatentability case — which has not been met in the present case. (*See In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).) Claim 21 is allowable for at least this reason.

Still further, by its express terms, claim 21 provides for *an arrangement configured to fix ... a mole fraction of a gas component drawn upon for the pressure measurement* The Stahl reference by itself, or in combination with the Joshi reference, does not disclose or suggest this feature. Indeed, the Office Action has not even addressed the feature of *fixing* a mole fraction of a gas component, let alone it being drawn upon for the pressure measurement upstream of the diffusion barrier, or it being fixed to a constant 100% as

provided in the context of the claimed subject matter. For this additional reason claim 21 is allowable.

In view of the foregoing, claim 21 is allowable, as are its dependent claims 22 to 24, 26, 30 to 36, 40 and 42.

Withdrawal of the obviousness rejections for claims 22 to 24, 26, 30 to 36, 40 and 42 is therefore respectfully requested.

V. Rejection of Claims 25 and 27 to 29 under 35 U.S.C. § 103(a)

Claims 25 and 27 to 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stahl in view of Joshi and further in view of U.S. Patent No. 6,338,782 to Imamura et al., (“Imamura”) and U.S. Patent No. 7,048,844 to Chen et al., (“Chen”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

Claims 25 and 27 to 29 ultimately depend from claim 21 and they are therefore allowable for essentially the same reasons, since the Imamura and Chen references do not cure – and are not asserted to cure – the critical deficiencies of the Stahl and Joshi references, as discussed above.

Withdrawal of the obviousness rejections of claims 25 and 27 to 29 is therefore respectfully requested.

VI. Rejection of Claim 37 under 35 U.S.C. § 103(a)

Claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stahl in view of Joshi and further in view of U.S. Patent No. 6,495,027 to Kato et al., (“Kato”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

Claim 37 includes features similar to those of claim 21 and it is therefore allowable for essentially the same reasons, since the Kato reference does not cure – and is not asserted to cure – the critical deficiencies of the Stahl and Joshi references, as discussed above with respect to claim 37.

Withdrawal of the obviousness rejection of claim 37 is therefore respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending and considered claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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